

REMARKS

Claims 1-20 are pending in this application. For purposes of expedition, claims 1-5 and 8-11 have been amended in several particulars for purposes of clarity and brevity, while Claims 16-20 have been newly added in accordance with current Office policy, to alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

As a preliminary matter, the Examiner acknowledges receipt of IDS filed on March 11, 2004 and May 10, 2004, but has not considered the Japanese patent documents contained therein because their English translations or translated abstracts were not provided. In response thereto, the translated abstracts of JP10322640, JP9274776, JP2001118321, JP10136314, and JP10162018 are enclosed for purposes of completeness and for the Examiner's consideration. Accordingly, entry of these Japanese patent documents as a matter of record is respectfully requested.

Claim 2 has been noted for allegedly containing terminology that is not what one skilled in the art would employ. Specifically, the Examiner asserts that "a preloading process" may be considered as a "loading process" and a "loading process" may be considered as a "rendering process." However, the Examiner's assertion is unwarranted in view of the original specification.

As clearly shown in FIG. 11, and described on paragraph [0059], the "preloading process" only involves reading the markup document, via reader 1, as shown in FIG. 5, and storing the same in a cache memory 3. In contrast to the "preloading process", the "loading process" requires interpreting the markup document and then loading the interpreted markup document onto a screen. Applicants are entitled to define specific process in the manner consistent with the specification. As a result, any objection should be withdrawn.

The specification has been objected to as failing to provide proper antecedent basis for the "computer-readable medium" as defined in claims 12-15. However, the objection is also unwarranted. Paragraph [0090], page 20 of Applicants' specification clearly describe that the functionalities of the presentation engine (6), as shown in FIG. 5, can be implemented by a set of instructions stored in machine-readable media. As a result, Applicants respectfully request that the objection be withdrawn.

Claims 1-15 have been rejected under 35 U.S.C. §112, 2nd ¶, as being indefinite. Specifically, the Examiner asserts that there is no nexus between the preamble and the body of

the claim as related to AV data. In response thereto, base claim 1 and dependent claims 2-7 have been amended to establish a nexus between "AV data" and "markup document" such that, after the "markup document" is loaded on a screen, the "AV data" corresponding to the "markup document" can be provided in a display window defined by the "markup document", as shown, for example, in FIG. 5. These unique features will advantageously enable a user to reproduce and interact with not only the "markup document" but also "AV data" corresponding to that "markup document". With regard to the Examiner's comments on claim 8, claim 8 has been amended to avoid the alternative expression noted. As amended, Applicants respectfully request that the rejection of claims 1-15 under 35 U.S.C. §112, 2nd ¶, be withdrawn.

Claims 1-7 and 12-15 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner alleges that base claim 1 reads on a mental process that could be carried out using paper and pencil and that is not within the technological arts. In response thereto, base claim 1 has been amended to render this rejection. Specifically, base claim 1 has been amended to clearly define specific steps as to how the method of reproducing AV data in an interactive mode using a markup document is implemented. In view of the foregoing amendments to claim 1, Applicants respectfully request that the rejection be withdrawn.

Claims 11 and 15 have been rejected under 35 U.S.C. §102(e) as being anticipated by Lamkin et al., U.S. Patent Application Publication No. 2002/0088011 (hereinafter referred to as "Lamkin '011"). In support of base claim 11 and its corresponding Beauregard claim 15, the Examiner asserts that Lamkin '011 discloses,

"A method of reproducing audio and/or visual (AV) data in an interactive mode using a markup document([0123]-[0124], [0131] and [0134]), the method comprising:
 interpreting the markup document and presenting the markup document comprising the AV data embedded therein on a screen [0065]-[0066]; and
 facilitating an interaction between the markup document and a user [0131] and [0134] thereby allowing the user to pulse and/or stop the presentation of the markup document. ([0134] esp. "Pause()", "Step()", "Stop()").

However, the Examiner's assertion is believed to be incorrect. There is no disclosure in Lamkin '011 of any reproduction of audio/visual (AV) data and markup documents in an interactive mode in which AV data corresponding to the markup document is embedded in the markup document loaded on a screen for presentation, and any interaction between the markup

document and the user which advantageously enables the user to pulse or stop the presentation on the markup document in the manner defined in Applicants' base claim 11. However, for purposes of expedition, base claim 11 has been amended to further clarify that both the "markup document" and the "AV data" are obtained from an information storage medium, as shown in FIG. 1, and that the user interacts with a reproduction apparatus, via a remote controller, as shown in FIG. 4.

In contrast to Applicants' base claims 11 and 15, Lamkin '011 discloses a system for providing enhanced DVD content for play at a client device 208, as shown in FIG. 2, across multiple playback platforms, ranging from computers (such as Windows and Macintosh) to Internet-connected set-top devices. ROM/HTML content 202 and DVD-video content 206 are recorded on the DVD disc 204 which is inserted into a client device 208 that contains Browser/Presentation software 210 (such as Netscape Navigator or some other forms of engine commonly available on personal computers). A typical client device 208 is shown in FIG. 1, including a CPU 110, RAM 114, ROM 116, I/O adapter 118 for connecting to a disk storage unit 120 (i.e., DVD playback device), interface adapter 122, display device 136 for connecting to a display unit 138, and communication adapter 134 for connecting to the Internet.

The Browser/Presentation software 210 is then activated, upon instruction from a user, to search the Internet to find supplemental information related to the DVD content 202, 206 and incorporate the supplemental information into the DVD content 202, 206 to create an Internet enhanced DVD experience 214. According to Lamkin '011, an InterActual Technologies Cross Platform ("ITX") specification is utilized to allow multiple playback platforms to seamlessly combine the Internet and/or other DVD-ROM capabilities with DVD-video to create a richer, more interactive, and personalized entertainment experience for customers.

The purpose of Lamkin's invention, as described on paragraph [0018], is to address the need for a system to easily and efficiently update content provided on a DVD-disk, via a network such as the Internet. Previously, the content is fixed once the DVD-disk is manufactured, and the content that the user can access from the DVD-disk is limited to the content provided when the disk is manufactured. In order to update the content, a new disk must be created and delivered to the user which can be expensive and inconvenient. On paragraph [0039], Lamkin '001 describes that "a preferred embodiment ... utilizes Hypertext Markup Language (HTML) to implement documents on the Internet together with a general-purpose secure communication protocol for a transport medium." As a result, HTML update must be accessed on-line, as shown in FIG. 3, and the content of the DVD-disk can be updated, as shown in FIG. 2A.

Nevertheless, the Examiner cites paragraphs [0131] and [0134] of Lamkin '011 for allegedly disclosing "facilitating an interaction between the markup document and a user thereby allowing the user to pulse and/or stop the presentation of the markup document." However, these citations can be misplaced. [0131] and [0134] of Lamkin '011 refer to ITX commands that are common in PCs in which DVD can be "paused" or "stopped". However, once those commands are executed, the entire playback of the DVD will either pause or stop. No distinction is made between the markup document or markup resources representing AV data files. No disclosure of any user ability to interact with a reproducing apparatus (i.e., DVD player), via remote controller, as shown in FIG. 4.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Lamkin '011 fails to disclose and suggest key features of Applicants' base claim 11 and its corresponding Beauregard claim 15. Therefore, Applicants respectfully request that the rejection of claims 11 and 15 be withdrawn.

Claims 1-7 and 12-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lamkin '011, as modified to incorporate selected features from Lamkin, U.S. Patent Publication No. 2002/0078144 ("Lamkin '144") for reasons stated on pages 8-11 of the

Office Action (Paper No. 20050808). In support of this rejection, the Examiner additionally cites Lamkin '144 for making reference to the use of "pseudo code" for operations in various states. Notwithstanding the irrelevancy of such "pseudo code" to establish different operation states, base claim 1 has been amended to render this rejection moot. Specifically, base claim 1 has been amended to define a method of reproducing audio and/or video (AV) data in an interactive mode using a markup document, comprising:

- obtaining the markup document and markup resources representing AV data files that are linked and embedded into the markup document, from an information storage medium; and
- enabling a user to interact with the markup document for presentation, via a presentation engine operable in a reproduction state, a pause state, and a stop state,
 - wherein the markup document is presented on a screen and selected markup resources representing AV data files are provided in a display window defined by the markup document on the screen according to a document life cycle, if the reproduction state is selected by the user, via a remote controller, and
 - wherein the presentation of the selected markup resources representing AV data files is paused or stopped, if the pause state or the stop state is selected by the user, via the remote controller.

As amended, there is no disclosure or suggestion from either Lamkin '011 or Lamkin '144, whether taken individually or in combination, of Applicants' endowed abilities of "enabling a user to interact with the markup document for presentation, via a presentation engine operable in a reproduction state, a pause state, and a stop state," "wherein the markup document is presented on a screen and selected markup resources representing AV data files are provided in a display window defined by the markup document on the screen according to a document life cycle, if the reproduction state is selected by the user, via a remote controller," and "wherein the presentation of the selected markup resources representing AV data files is paused or stopped, if the pause state or the stop state is selected by the user, via the remote controller" as defined in base claim 1.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must

be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Lamkin '011 and Lamkin '144 fail to disclose and suggest key features of Applicants' base claim 1. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

More importantly, claims 8-10 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Michael Morrison et al., (XML Unleashed, Sam's Publishing, Indianapolis, IN, Dec. 1999, pp. 149-153, 174-179, 184-202, 206-209, 290, 424, 427, 431-443 and 463-467) (hereinafter referred to as "Morrison") in view of Lamkin '144 for reasons stated on pages 12-14 of the Office Action (Paper No. 20050808). In support of this rejection, the Examiner additionally cites Morrison's text book to disclose the specific method embodiments of Applicants' claimed "presentation engine" as shown in FIG. 5 and FIG. 6. However, Morrison simply provides a text book on how to program web pages in XSL and HTML languages. Similar to the noted deficiencies of Lamkin '011 and Lamkin '144, there is no disclosure of specific implementation procedure on how a markup document is prepared and presented in an interactive mode, including:

- interpreting the markup document and generating a document object tree according to a predetermined rule;

- interpreting a stylesheet to define a document form of the markup document and generating a style rule/selector list;

- interpreting a script code that is included in the markup document;

- applying the style rule/selector list to the document tree to create a document form;

generating a formatting structure that corresponds to the document form;
rendering the markup document according to the format structure;
decoding markup resources representing AV data linked to the markup document
and outputting the markup document rendered along with the markup resources
representing AV data for presentation on a screen in which the markup resources
representing AV data are provided in a display window defined by the markup
document.

In view of these reasons and the noted deficiencies of the proposed combination,
Applicants respectfully request that the rejection of claims 8-10 and 14 under 35 U.S.C. §103(a)
as being unpatentable over Michael Morrison and Lamkin '144 be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to
be allowable and this application is believed to be in condition to be passed to issue. Should
any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at
the Washington DC office at (202) 216-9505 ext. 232. Applicants respectfully reserve all rights
to file subsequent related application(s) (including reissue applications) directed to any or all
previously claimed limitations/features which have been amended or canceled, or to any or all
limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or
surrender any limitations/features of the disclosed invention to the public.

To the extent necessary, Applicants petition for an extension of time under 37 CFR
§1.136. If there are any additional fees associated with filing of this Amendment, please charge
the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 11/21/05

By: Hung H. Bui
Hung H. Bui
Registration No. 40,415

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510